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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,036	12/09/2003	Kathleen Lane	LANE-SEC-US	6726
7590	05/03/2006		EXAMINER	
PATRICK REILLY BOX 7218 SANTA CRUZ, CA 95061-7218			NGUYEN, NAM V	
			ART UNIT	PAPER NUMBER
			2612	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/731,036	LANE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Nam V. Nguyen	2612	

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12/09/06.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 8 and 9 is/are allowed.
- 6) Claim(s) 1-7 and 10-26 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 December 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                             |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                        | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

The application of Lane et al. for a “secure personal RFID documents and method of use” filed December 09, 2003 has been examined.

This application is a CIP of 10/456,454 which is filed on June 7, 2003 which claims priority to U.S. provisional application number 60/428,529, which is filed on November 23, 2002.

Claims 1-26 are pending.

### ***Information Disclosure Statement***

An information disclosure form (PTO-1449) listing the references was not enclosed in the application.

### ***Drawings***

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

The drawings are objected to under 37 CFR 1.83(a) because they fail to label boxes (4, 10-12, 20, 40) in Figure 1, label boxes (4A to 4G) in Figure 2, label boxes (24-34) in Figure 4 and label boxes (44-70) in Figure 7 as described in the specification. Any structural detail that is

essential for a proper understanding of the disclosed invention should be shown in the drawing.

MPEP § 608.02(d).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference signs mentioned in the detailed description on page 34: an Internet 22.

Referring to Figure 8, the drawings are objected to because is not in a flow chart layout.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Claim Objections*

Claims 24-26 are objected to because of the following informalities: the acronym “XML”, “SSN”, “URL” are not defined by the claim.

An appropriate correction is required.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6, 8-9 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

No where in the specification describe in such full and clear as to enable “No where in the specification describe the limitation that “2<sup>nd</sup> digital code is not readable from the durable memory” (see specification paragraph 0025). One skilled in the art would not know how the reader read the 2<sup>nd</sup> digital code in order for certification for authentication when the 2<sup>nd</sup> digital code is not readable from the durable memory? Is it read only memory? Is read only memory

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with security feature for reading the 2<sup>nd</sup> digital code? Where is this limitation supported by specification?

In claim 1, the phrase "accuracy of the secure document is based at least partly on the 1<sup>st</sup> digital code stored within the IC" is confusing and unclear. It is not understood what is meant by such a limitation. Is it part of the 1<sup>st</sup> digital code certificate for authentication? What is at least partly mean? Is it at least partially on the basis of the first authorization key?

In claim 6, the phrase "wherein the 2<sup>nd</sup> digital code is used to control access to the secure document and the 1<sup>st</sup> digital code" is confusing and unclear. It is not understood what is meant by such a limitation. How is 2<sup>nd</sup> digital code control the secure document? Is it use the second code in order to access the secure document and the first digital code?

Claim 8 recites the limitation "the biometric event" in line 10. There is insufficient antecedent basis for this limitation in the claim

In claim 8, the phrase "whereby a change in the primary or secondary document may automatically update a plurality of documents that are linked to either the primary or the secondary document" is confusing and unclear. It is not understood what is meant by such a limitation. Is the system update information in the memory? What change takes place in the documents?

Claim 17 recites the limitation "the secret document" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Referring to claims 2-5 and 9 are rejected as being dependent upon a rejected Claims 1 and 8 above.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yap et al. (US# 6,111,506) in view of Hopkins (US# 5,757,918).

Referring to Claims 1 and 10, Yap et al. disclose a system and a secure document (10) (i.e. a security identification document) containing: a flexible substrate (12) having a surface (column 12 line 28 to 39; see Figures 1 to 5), the surface visibly presenting information (column 14 lines 17 to 21); and

an integrated circuit (15) (i.e. a metal ring surround an integrated circuit) coupled with the substrate (12), the integrated circuit (15) including: a durable memory (i.e. embedded in microprocessor 14), the durable memory storing a 1<sup>st</sup> digital code (i.e. secure identification data), wherein the 1<sup>st</sup> digital code is related to a life factor (i.e. birth certificate data, driver's license

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data information) (column 5 lines 45 to column 6 line 33; column 12 lines 43 to 58; see Figures 1 and 7), and whereby certification for the authentication and/or accuracy of the secure document (10) is based at least partly on the 1st digital code (identification data) stored within the integrated circuit (15) (column 7 line 12 to 67; column 8 line 40 to 65; column 14 line 53 to column 16 line 54; see Figures 1 to 8).

However, Yap et al. did not explicitly disclose a 2<sup>nd</sup> digital code and a 2<sup>nd</sup> digital code is not readable from the durable memory.

In the same field of endeavor of an identification transponder, Hopkins teaches that a 2<sup>nd</sup> digital code (aB) (i.e. a secret value) and a 2<sup>nd</sup> digital code is not readable (i.e. not readable by the terminal) from the durable memory (31) (column 5 lines 56 to 64; see Figures 1 to 5) in order to secure the smart card reading terminal and the host computer and to avoid counterfeit card.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to recognize using the secret value (aB) and the secret value of aB can not be read by the reading terminal taught by Hopkins in an improved security identification document of Yap et al. because the secret value is not transmit to the reading terminal would avoid duplication or counterfeit of the identification of the smart card.

Referring to Claims 2 and 12, Yap et al. in view of Hopkins disclose the system and the secure document of claims 1 and 10, Yap et al. disclose wherein the life factor is related to an event of a specific human being, the event selected from the group consisting of a birth of a human being (column 4 line 2 to 24; column 14 line 8 to 37).

Referring to Claims 3 and 13, Yap et al. in view of Hopkins disclose the system and the secure document of claims 1 and 10, Yap et al. disclose wherein the life factor is related to an aspect of a specific human being, the aspect selected from the group consisting of a biometric pattern (column 4 lines 38 to 59; column 5 line 7 to 23; column 6 line 45 to 51).

Referring to Claims 4 and 11, Yap et al. in view of Hopkins disclose the system and the secure document of claims 1 and 10, Yap et al. disclose wherein the integrated circuit is an RFID (column 5 line 64 to column 6 line 16; column 7 lines 36 to 43; see Figures 1 to 7).

Referring to Claim 5, Yap et al. in view of Hopkins disclose the secure document of claim 1, Hopkins discloses wherein the 2<sup>nd</sup> digital code (aB) (i.e. a secret value) is secret key, and the key is configured for use in an encryption method (column 2 lines 62 to 65).

Referring to Claim 6, Yap et al. in view of Hopkins disclose the secure document, to the extent as claimed with respect to claim 1 above, and Hopkins disclose wherein the 2<sup>nd</sup> digital code (aB) (i.e. a secret value) is used to control access to the secure document (12) (i.e. smart card) and the 1<sup>st</sup> digital code (e or n) (i.e. value of public key), and wherein the 2<sup>nd</sup> digital code (aB), once it is initially written into the secure document (12), is never transmitted to or from the secure document again (i.e. the secret value aB never transmit to the terminal) (column 5 lines 2 to 13; column 5 lines 52 to 64; see Figure 3).

Referring to Claim 7, Yap et al. in view of Hopkins disclose the secure document, to the extent as claimed with respect to claim 1 above, and Yap et al. disclose an information technology system (60) (i.e. a security system) for periodically associating an identity of a specific human being to the document (10) via at least one bio-metric measurement (72) (i.e. biometric data input device); and a security system (64) (i.e. a computer) for recording a personal identification number, or "PIN", on the document (10) and the security system (64) protecting the PIN from unauthorized reading from the document (10) (column 14 line 54 to column 16 line 11; see Figures 1 to 7).

Referring to Claims 14-15, 17-19 and 21-26, Yap et al. disclose a system (60) (i.e. a security system) for life events record authentication, the system (60) comprising:

a document (10) having a flexible substrate (12) and an integrated circuit (15), the flexible substrate (15) having a surface, the surface visibly presenting information (column 4 line 2 to 24; column 12 line 28 to 42; see Figures 1 to 5);

the integrated circuit (15) coupled with the substrate (12), the integrated circuit (15) including: a durable memory (i.e. embedded in microprocessor 14) containing a first information (i.e. secure identification data), wherein the first information is related to information selected from the group consisting of (i.e. biometric data) (column 4 lines 38 to 59; column 5 lines 45 to column 6 line 33; column 12 lines 43 to 58; see Figures 1 and 7),

However, Yap et al. did not explicitly disclose wherein an authentication of the document is based at least partly on the at least one secret key; wherein access to the first information requires the use of the secret key; and wherein the secret key may be communicated by private

means from a first agency to a second agency and the secret key may be used to delegate authority from the first authority to the second authority.

In the same field of endeavor of a portable security device, Hopkins discloses an authentication of the document (12) (i.e. a smart card) is based at least partly on the at least one secret key (aB) (i.e. a secret value) (column 2 line 45 to 67; see Figures 1 and 2); wherein access to the first information (U) (i.e. public information) requires the use of the secret key (U) (column 3 lines 1 to 60; see Figure 1); and wherein the secret key (U) may be communicated by private means (26) from a first agency (20) (i.e. a card issuer site) to a second agency (22) (i.e. a terminal) and the secret key (U) may be used to delegate authority from the first authority (20) to secure verification and authentication system.

One of ordinary skilled in the art recognizes the need for the terminal to verify the smart card by a secret value taught by Hopkins in a security identification document of Yap et al. because Yap et al. suggest it is desired to provide that the memory in the document with a RFID integrated circuit can be used to store a plurality of security identification data of a user (column 5 line 45 to 68; column 6 line 45 to 67) and Hopkins teaches that a terminal verifies the smart card for counterfeit and that the user is authorized by the value of secret key (column 5 line 1 to column 6 line 65; see Figures 1 to 3) in order to improve security at the terminal for verifying a smart card and the user. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to have a the terminal to verify the smart card by a secret value taught by Hopkins in a security identification document of Yap et al. with the motivation for doing so would have been to provide a secure communicating in each of the cards in a programmable security identification document.

Referring to Claims 16 and 20, Yap et al. in view of Hopkins disclose the system and the secure document of claims 14 and 18, Yap et al. disclose wherein the integrated circuit is an RFID (column 5 line 64 to column 6 line 16; column 7 lines 36 to 43; see Figures 1 to 7).

***Allowable Subject Matter***

Claims 8-9 are allowed.

Referring to claim 8, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations the primary document and secondary digital code are permanently associable with each other, and whereby a change in the primary or secondary document may automatically update a plurality of document that are linked to either the primary or the secondary document.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Olah (US# 5,296,218) discloses a portable security system using communicating cards.

Carrol et al. (US# 5,517,188) disclose a programmable identification apparatus and method therefor.

Moskowitz et al. (US# 5,528,222) disclose a radio frequency circuit and memory in thin flexible package.

Brady et al. (US# 6,100,804) disclose a radio frequency identification system.

Tutt et al. (US# 6,785,739) disclose a data storage and retrieval playback apparatus for a still image receiver.

Hansmann et al. (US# 6,892,301) disclose a method and system for securely handling information between two information processing devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nam V Nguyen whose telephone number is 571-272-3061. The examiner can normally be reached on Mon-Fri, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on 571- 272-7308. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nam Nguyen  
April 20, 2006



BRIAN ZIMMERMAN  
PRIMARY EXAMINER